

REMARKS

The Applicant's undersigned attorney thanks the Examiner for the courtesies extended during the October 4, 2004 telephone interview. In the interview, the undersigned attorney indicated that an additional patent, U.S. Patent No. 2,945,534 to Hawkinson, would be cited in an Information Disclosure Statement which would be filed with the response to the outstanding Official Action. The rejections in view of the Hawkinson patents of record were then discussed in detail. The Examiner reiterated the position taken in the prior Office Action with respect to the carriage/upright/mandrell. The Applicant's attorney pointed out that the carriage 17 in Fig. 10 of Hawkinson '476 and as described in column 3 lines 45 et. seq. moves in a different direction than that provided in Applicant's claims. In response, the Examiner indicated that additional carriages providing additional movement capabilities in the Hawkinson references were not excluded by the pending claims. It was also discussed that the rails as depicted and described in Applicant's application are both in essentially the same horizontal plane, whereas in the Hawkinson references the various "carriages" and rails are at widely different vertical positions.

No agreement was reached, but the Examiner indicated that any changes to the claims would be fully considered when presented. In light of the interview, the claims have been amended as summarized below. Favorable reconsideration is requested.

II. Status of the Claims

Claims 2 through 10 are pending. Claim 1 has been cancelled and independent claim 10 has been added to address the rejection of this application in the Official Action. Support for the amendment is found in the specification, particularly in paragraphs 0020, 0022, 0023, 0024, 0026, 0027, and 0028, as well as in Figs. 1 and 2. Claims 2, 4, 5, 6, 8 and 9 have been amended

to reflect dependency on new claim 10. Entry of the amendment and favorable reconsideration are respectfully requested in light of these remarks.

II. Rejections Under 35 U.S.C. §§ 102(b) and 103(a)

The previously presented claims 1-4, 6 and 7 were rejected under 35 U.S.C. § 102(b) as allegedly anticipated by the Hawkinson references, U.S. Patent No. 2,965,162 (“Hawkinson”) or by U.S. Patent No. 3,528,476 (“Hawkinson, Jr.”). The Examiner asserts that claims 1-4, 6 and 7 are anticipated by the Hawkinson references, that claim 7 is obvious in view of those patents, and that claims 5, 8 and 9 are obvious over those patents alone or further in view of the admitted state of the prior art and the Andersson et al., Marangoni and/or Schmidt patents. The essential bases of these rejections are the Examiner’s contentions that (a) the element 24 in Hawkinson, Jr., ‘476 “is a vertical upright on a carriage which supports the shaft” and (b) “in Hawkinson ‘162, the carriage ‘13’ supports what can be termed a ‘vertical upright’ (not separately numbered but part of ‘8’) which in turn supports shaft ‘9’”.

The Claimed Invention

The amended claims cover an apparatus for recapping tires comprising a horizontal rigid frame comprising a first horizontal modular structure and a second horizontal modular structure. The first structure comprises a first set of rails for guiding a first carriage having a vertical upright which supports a rotational shaft on which is fitted a mandrel for support of a tire. The mandrel is mounted for translation on the first structure in a direction parallel to the rotational shaft.

The second structure comprises a second set of rails for guiding a second carriage on which recapping tools are fitted. The recapping tools are mounted for translation on the second structure in a direction approximately perpendicular to the direction of translation of the mandrel.

The first and the second structures are arranged perpendicular to one another. The first set of rails and the second set of rails are disposed in essentially the same horizontal plane.

The Claimed Invention Is Not Anticipated By The Cited Art

Consideration of the Hawkinson references shows the important distinctions between the instant claimed invention and the cited art. Attention is invited to Applicant's prior response filed on June 9, 2004, and in particular to page 6 where it is noted that Hawkinson states in column 2 lines 5-23:

A rigid upright tubular pedestal 5 extends upwardly from the base 1 adjacent one side thereof, and is provided at its lower end with a mounting flange 6 that is rigidly secured to the base 1 by means of anchoring screws or the like 7. At its upper end, the pedestal 5 carries mechanism, indicated generally at 8, for rotatively mounting a shaft 9 on a horizontal axis, the mechanism 8 including an electric motor 10 and power transmission gearing not shown, but contained within a gear housing 11 for imparting rotary movement to the shaft 9. The shaft 9 is adapted to have mounted thereon a wheel 12 which carries a tire X to be buffed. The mechanism 8, together with the shaft 9, wheel 12, and tire X, is adjustable transversely of the pedestal 5, the mechanism 8 being mounted on a slide member 13 mounted in guideways 14 at the upper end of the pedestal 5, adjustment being

had through the medium of an adjustment screw 15 to one end of which is secured a handwheel 15.

Note that any rails that can be inferred in the guideways 14 are well above guide rails 16 (which enable translation of the buffing tools) and thus are not disposed in essentially the same horizontal plane as required by the amended claims.

Similarly in Hawkinson, Jr., any rails that could be inferred adjacent shaft 29 are well above guide rails 45 (which enable translation of the buffing tools) and thus are also not disposed in essentially the same horizontal plane, as required by the amended claims.

In view of the fact that neither Hawkinson nor Hawkinson, Jr. is an anticipatory reference, it is respectfully requested that the 35 U.S.C. § 102(b) rejection be withdrawn.

The Claimed Invention Is Not Obvious In View Of The Cited Art

The Remarks in response to the rejections in Applicant's Amendment filed on June 9, 2004 are incorporated herein by reference. In addition, the Applicant notes that there is no suggestion in any of the references of elements in the instant amended claims, and thus, there is no *prima facie* case of obviousness.

To establish a *prima facie* case of obviousness, three criteria must be met. First, there must be some suggestion or motivation in the cited references themselves or in the knowledge generally available to one of ordinary skill in the art to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Third, the combined references must teach or suggest all the claimed limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and must not be based on the applicants' disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ 2d 1438 (Fed. Cir. 1991); MPEP § 2142.

In this case, there is no suggestion or motivation in any of the cited references to construct an apparatus for recapping tires wherein each of the mandrel and the recapping tools are mounted for translation on sets of rails that are disposed in essentially the same horizontal plane. None of the references suggests Applicant's elegant solution to the problems of vibration and instability. The Hawkinson references and the other cited art disclose apparatuses more complicated than Applicant's claimed invention.

Accordingly, Applicant submits that Claim 10 is patentable over the cited art, and respectfully requests withdrawal of the rejection under 35 U.S.C. § 103(a). The other claims in the present application depend from Claim 10 and therefore are submitted to be patentable for at least the above reasons. Because each dependent claim is also deemed to define an additional aspect of the invention, individual consideration or reconsideration, as the case may be, of the patentability of each claim on its own merits is respectfully requested.

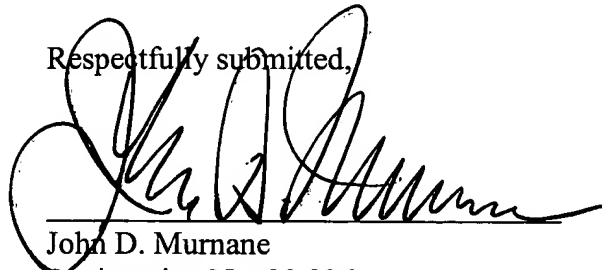
The present Amendment is believed clearly to place this application in condition for allowance. Should the Examiner believe that issues remain outstanding, it is respectfully requested that the Examiner contact Applicant's undersigned attorney in an effort to resolve such matters and advance the case to issue.

In view of the foregoing amendments and remarks, Applicants earnestly solicit favorable reconsideration and early passage to issue of the present application.

CONCLUSION

Applicants' undersigned attorneys may be reached in our New York Office by telephone at (212) 218-2100. All correspondence should continue to be directed to our address listed below.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'John D. Murnane', written over a horizontal line.

John D. Murnane
Registration No. 29,836
(212) 218-2527

Alicia A. Russo
Registration No. 46,192
(212) 218-2568

Attorneys for Applicants

FITZPATRICK, CELLA, HARPER & SCINTO
30 Rockefeller Plaza
New York, New York 10112-3801
Facsimile: (212) 218-2200